

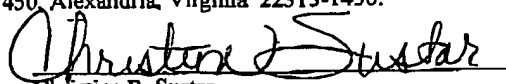
PATENT

01AB121/ALBRP112USB

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being faxed to 703-308-9339 on the date shown below to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Date: 3-8-06

  
Christine R. Sustar

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of:

Applicant(s): Fred Discenzo, *et al.*

Serial No: 09/965,545

Filing Date: September 27, 2001

Examiner: Jungwon Chang

Art Unit: 2154

Title: MOTORIZED SYSTEM INTEGRATED CONTROL AND DIAGNOSTICS  
USING VIBRATION, PRESSURE, TEMPERATURE, SPEED AND/OR  
CURRENT ANALYSIS

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

---

**REPLY BRIEF**

---

Dear Sir:

Appellants' representative submits this Reply Brief in response to the Examiner's Answer dated December 28, 2005. A Request for Oral Hearing and a credit card payment form are filed concurrently herewith, wherein the credit card payment form is believed to cover all fees due regarding this document and the Request for Oral Hearing. Appellants' representative hereby respectfully requests to present arguments via telephone in accordance with MPEP §1209. In the event any additional fees may be due and/or are not covered by the

09/965,545

01AB121/ALBRP112USB

---

credit card, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063 [ALBRP112USB].

09/965,545

01AB121/ALBRP112USB

**REMARKS**

Claims 1-8, 12-22, and 24-42 are currently pending in the application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

**A. Rejection of claims 1, 19, and 22 Under 35 U.S.C. §102(e)**

Claims 1, 19, and 22 stand rejected under 35 U.S.C. §102(e) as being anticipated by McConnell *et al.* (U.S. 6,002,232). It is respectfully requested that this rejection be withdrawn for at least the following reasons. McConnell *et al.* fails to disclose each and every element of the subject claims.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the...claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The subject invention relates to systems and methods for controlling and diagnosing the health of a machine, and more particularly, to systems and methods for controlling and diagnosing motorized systems according to vibration, pressure, temperature, speed, and/or current analysis. Independent claim 1 sets forth “A method for controlling a motorized system comprising: measuring an attribute of the motorized system, the attribute comprises at least one of vibration, speed, temperature, pressure, and current in the motorized system; diagnosing a health of the motorized system based on the measured attribute; providing a diagnostics signal based on the diagnosed health; prognosing a state of the motorized system based at least in part on the at least one sensed attribute and/or the diagnosed state; providing a control signal based at least in part on the diagnosed health and the prognosed state; **and providing a feedback operation that adjusts the control signal to extend the lifetime of the motorized system to a specific time horizon.**” Independent claims 19 and 22 recite similar aspects. The subject

09/965,545

01AB121/ALBRP112USB

specification is replete with support for the claimed aspects: for instance, according to an example described at pages 24-25, "...an appropriate *control signal 64* may be provided by the controller 71 to the motor drive 60 in order to avoid anticipated cavitation, *based on the diagnostics signal 72* (e.g., and/or the setpoint 19), whereby the *service lifetime* of one or more system components (e.g., pump 14) *may be extended*. The control signal 64 can further be provided to reduce cavitation to a prescribed low level to meet process constraints and *to extend machinery lifetime to a specific time horizon* (e.g., to allow for mission completion)." (Page 24, line 26 – page 25, line 3.) Moreover, "Subsequent diagnostics on the system with modified control *can confirm, in a feedback operation...* whether a new, *extended operating lifetime will be obtained*." (Page 4, lines 20-23.) Thus, the subject claims set forth feedback-enabled control of a system to extend operating lifetime to a specific time horizon, rather than merely extending operating lifetime to some ambiguous future time. McConnell *et al.* does not describe such claimed aspects of the subject invention.

McConnell is directed toward suppressing vibration in a physical system *via* analysis of frequency spectra of a command input that is selected according to various parameters. The examiner contends that McConnell *et al.* describes the claimed aspect of "prognosing a state of the motorized system based at least in part on the at least one sensed attribute," citing column 7, lines 50-59 and Fig. 2. Additionally, the subject claims recite "providing *a control signal* based at least in part *on the diagnosed health and the prognosed state...*" McConnell *et al.* merely mentions selecting a command signal and evaluating a noise generation *potential* there for based on analysis of *a table lookup* of a frequency spectrum for the command signal, upon which aspect it appears the Examiner relies to describe prognosing a state of the system. If the analysis of the command signal attributes is satisfactory, then the command signal is applied to the system. *Only after application of the command signal* does McConnell *et al.* employ any diagnostic action. Thus, McConnell *et al.* discusses employing a *predicted value as determined from a table lookup* to select a command signal that can be applied to a system *for later diagnosis*. Thus, McConnell *et al.* does not describe each and every element as set forth in the subject claims.

09/965,545

01AB121/ALBRP112USB

Additionally, McConnell *et al.* is silent with regard to the aspect of “a feedback operation that adjusts the control signal to extend the lifetime of the motorized system to a specific time horizon,” as set forth in the amended independent claims. Nowhere in the Examiner’s cited sections or otherwise does McConnell *et al.* even mention a feedback operation that adjusts a control signal to control system lifetime duration.

“Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Mehl/Biophile Int’l Corp. v. Milgraum*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305 (Fed. Cir. 1999), reh’g denied, 1999 U.S. App. LEXIS 31386 (Fed. Cir. Oct. 37, 1999) (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ323, 326 (CCPA 1981)).

The Examiner has maintained the contention that the claimed aspect of adjusting a control signal to extend system lifetime *to a specific time horizon* is inherent to the McConnell reference because McConnell *et al.* relates to vibration reduction and because unwanted vibrations reduce the lifetime of system components. Still furthermore, the Examiner contended in the Final Office Action dated March 31, 2005 that by reducing vibrations, McConnell *et al.* inherently extends the lifetime of the motorized system to a specific time horizon, where a “specific time horizon” is interpreted broadly as referring to the time when the system will fail to operate consistently, predictably, or accurately, citing a definition from techdictionary.com.

The definition cited by the Examiner in the Final Office Action dated March 31, 2005 defines “time horizon” as “a point in time beyond which a system element will fail to process consistently...” In contrast, in the Examiner’s Answer dated December 28, 2005, the Examiner contends that “specific time horizon” is interpreted as “a broad limitation which includes various interpretations such as ‘extending mission completion,’ as described in the specification at page 25, lines 1-3.” The subject independent claims set forth a “specific time horizon,” such as mission completion, *etc.*, to which system operation lifetime can be extended based on adjustments to a control signal that are facilitated by diagnoses and prognoses related to system health. Even if the Examiner’s

09/965,545

01AB121/ALBRP112USB

definition of “time horizon” were acceptable, nothing in the cited references describes controlling a system to ensure that the system operates beyond a *specific* time horizon.

Moreover, it is respectfully pointed out that dictionaries are no longer an acceptable basis for claim construction. (*See generally, Phillips v. AWH Corp.*, No. 03-1269, 75 USPQ2d 1321 (Fed. Cir. 7/12/05), (70 PTCJ 309 7/15/05).) The mere fact that a system can be calibrated to reduce vibration does not inherently disclose providing control signal adjustments that extend system operation lifetime to a *specific* time horizon. Thus, McConnell *et al.* fails to describe such aspects of appellants’ claimed invention.

In view of the foregoing, it is readily apparent that McConnell *et al.* does not anticipate or make obvious the appellants’ invention as recited in the subject claims. Therefore, this rejection should be withdrawn.

**B. Rejection of Claims 1-5, 18-22, 24, 30, 35-38, 40 and 41 Under 35 U.S.C. §102(e)**

Claims 1-5, 18-22, 24, 30, 35-38, 40 and 41 stand rejected under 35 U.S.C. §102(e) as being anticipated by Madhavan (U.S. 6,004,017). Withdrawal of this rejection is respectfully requested for at least the following reasons. Madhavan does not disclose each and every aspect of the present invention as set forth in the subject claims.

As stated above with regard to Section A, the subject independent claims set forth the aspect of *extending motorized system function until a specific time horizon is reached* based on diagnostic and prognostic information related to system health. As set forth with regard to McConnell *et al.*, Madhavan fails to disclose such aspects of the subject claims. However, as with the rejection under McConnell *et al.*, the Examiner maintains the contention that such aspects of the subject claims are inherent in Madhavan.

As stated in the Appeal Brief, Madhavan merely discloses an algorithm for *predicting or avoiding* an episode of “chatter” in a machining tool. Chatter is a “self-excited relative vibration between the workpiece and the cutting tool in common machining processes such as turning processes on a lathe...” (Column 1, lines 30-33.) Madhavan does not disclose *adjusting a control signal to extend operating life to a specific time horizon* as set forth in the subject independent claims. As with McConnell

09/965,545

01AB121/ALBRP112USB

*et al.*, the Examiner relies on an inherency argument to introduce the claimed aspect of the specific time horizon, contending that the stated object of the Madhavan invention is to extend the lifetime of a system, which the Examiner states, is equivalent to the claimed aspect of extending system lifetime operation to a specific time horizon. However, as stated above, the mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency. To interpret the claimed aspect of extending system lifetime "to a specific time horizon" as meaning merely "indefinitely" is to negate the phrase entirely.

Thus, Madhavan fails to anticipate or make obvious appellants' invention as set forth in independent claims 1, 19, 22, and 36 (and claims 2-5, 18-22, 24, 30, 35-38, and 40-41, which depend respectively there from). This rejection should be withdrawn.

**C. Rejection of Claims 6-8, 12-14, 25-29, and 42 Under 35 U.S.C. §103(a)**

Claims 6-8, 12-14, 25-29, and 42 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Madhavan (U.S. 6,004,017) in view of Hays *et al.* (U.S. 6,260,004). This rejection should be withdrawn for at least the following reasons. Neither Madhavan nor Hays *et al.*, alone or in combination, teach or suggest all of the claimed aspects of the present invention as set forth in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) ***must teach or suggest all the claim limitations***. See MPEP §706.02(j). The ***teaching or suggestion to make the claimed combination*** and the reasonable expectation of success ***must both be found in the prior art and not based on applicant's disclosure***. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

09/965,545

01AB121/ALBRP112USB

As discussed above, independent claims 1, 22, and 36 set forth the aspect of a *feedback operation that adjusts the control signal to extend the lifetime of the motorized system to a specific time horizon*. Neither of the Examiner's cited references teaches or suggest such aspect of the claimed invention, as discussed above in Sections B and C.

Accordingly, it is readily apparent that neither Madhavan nor Hays *et al.*, alone or in combination, teach or suggest all of the claimed aspects of independent claims 1, 22, and 36 (and claims 6-8, 12-14, 25-29, and 42, which depend respectively there from). Withdrawal of this rejection is respectfully requested.

**D. Rejection of Claims 15-17, and 31-34 Under 35 U.S.C. §103(a)**

Claims 15-17 and 31-34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Madhavan (U.S. 6,004,017) in view of Edison *et al.* (5,586,305). Withdrawal of this rejection is respectfully requested for at least the following reasons. Neither Madhavan nor Edison *et al.*, alone or in combination, teach or suggest the present invention as set forth in the subject claims.

Claims 15-17 and 31-34 depend from independent claims 1 and 22 respectively. As discussed above in Sections B and C, Madhavan does not teach or suggest “a *feedback operation that adjusts the control signal to extend the lifetime of the motorized system to a specific time horizon*” as set forth in independent claims 1 and 22. Edison *et al.* fails to overcome the deficiencies of Madhavan and McConnell *et al.* with respect to the subject independent claims.

In view of the above comments, it is respectfully submitted that the combination of Madhavan and Edison *et al.* does not make obvious the subject invention as recited in independent claims 1 and 22 (and claims 15-17 and 31-34 which respectively depend there from). Therefore, this rejection should be withdrawn.

**E. Rejection of Claim 39 Under 35 U.S.C. §103(a)**

Claim 39 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Madhavan (U.S. 6,004,017) in view of Grayson *et al.* (U.S. 5,111,531). Withdrawal of this rejection is respectfully requested for at least the following reasons. Claim 39 depends from independent claim 36, which, as discussed above in Section B, is not made



09/965,545

01AB121/ALBRP112USB

obvious by Madhavan. Grayson *et al.* fails to overcome the deficiencies of Madhavan with respect to independent claim 36. Specifically, Grayson *et al.* does not teach or suggest a diagnostics system that “*ensures that the motorized system will function until a predetermined time horizon is reached.*” Appellants’ representative appreciates the Examiner’s clarification that the Examiner is not relying on Grayson *et al.* to teach the above aspect. However, Grayson *et al.* is combined by the Examiner with a primary reference (Madhavan) that fails to teach the above aspect of the base claim, and thus the subject aspect is not taught by either reference. Moreover, the Examiner’s maintained inherency argument amounts to removal of the aspect of ensuring system function “until a predetermined time horizon” from the claimed “diagnostics system [that] further performs at least *a second diagnosis* of the state of the motorized system *after corrective action* is taken by the control component and *ensures that the motorized system will function until a predetermined time horizon is reached.*”

In view of at least the above, this rejection should be withdrawn.

09/965,545

01AB121/ALBRP112USB

**F. Conclusion**

For at least the above reasons, the claims currently under consideration are believed to be patentable over the cited references. Accordingly, it is respectfully requested that the rejections of claims 1-8, 12-22, and 24-42 be reversed.

If any additional fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin

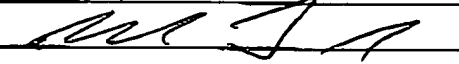
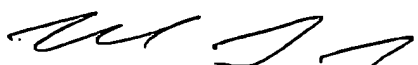
Reg. No. 40,894

AMIN & TUROCY, LLP  
24<sup>TH</sup> Floor, National City Center  
1900 E. 9<sup>TH</sup> Street  
Cleveland, Ohio 44114  
Telephone (216) 696-8730  
Facsimile (216) 696-8731

PTO/SB/32 (08-03)

Approved for use through 07/31/2006. OMB 0851-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>REQUEST FOR ORAL HEARING BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES</b>		Docket Number (Optional) <b>01AB121/ALBRP112USB</b>	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450", or via facsimile to (571) 273-8300. on <u>March 8, 2006</u>		In re Application of <b>Fred Discenzo, et al.</b> <hr/> Application Number <u>09/965,545</u> Filed <u>September 27, 2001</u> <hr/> For <b>MOTORIZED SYSTEM INTEGRATED CONTROL</b> <hr/> Art Unit <u>2154</u> Examiner <u>Jungwon Chang</u>	
Signature <u></u> Typed or printed name <u>Himanshu S. Amin</u>			
Applicant hereby requests an oral hearing before the Board of Patent Appeals and Interferences from in the appeal of the above-identified application.			
The fee for this Request for Oral Hearing is (37 CFR 1.17(d))		\$ <u>1000.00</u>	
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is:		\$ _____	
<input type="checkbox"/> A check in the amount of the fee is enclosed.			
<input checked="" type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.			
<input type="checkbox"/> The Director has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.			
<input checked="" type="checkbox"/> The Director is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. <u>50-1063</u> .			
<input type="checkbox"/> A petition for an extension of time under 37 CFR 1.136(b) (PTO/SB/23) is enclosed. For extensions of time in reexamination proceedings, see 37 CFR 1.550.			
<b>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</b>			
I am the			
<input type="checkbox"/> applicant/inventor.		<u></u> Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		<u>Himanshu S. Amin</u> Typed or printed name	
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>40,894</u>		<u>(216) 696-8730</u> Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34(a). Registration number if acting under 37 CFR 1.34(a) _____		<u>March 8, 2006</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 37 CFR 1.184(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.